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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KONSTANTINOS POULAKIS
and AXEL SCHULTE

Appeal 2009-005118
Application 09/743,710
Technology Center 1700

Decided:[1] July 30, 2009

Before ADRIENE LEPIANE HANLON, PETER F. KRATZ, and CATHERINE Q. TIMM, *Administrative Patent Judges*.

HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 from an Examiner's decision rejecting claims 9-18.[2] The instant Application was remanded to the jurisdiction of the Examiner on two separate occasions.[3] However, our consideration of the record leads us to conclude that the Application is now in condition for a decision on appeal. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

The subject matter on appeal is directed to a method for producing a foam body part, such as a foam padding element for a vehicle seat, having at least one adhesive closing part with adhering elements. The adhesive closing part is arranged in a foaming mold in such a manner that the adhering elements are protected against the penetration of foam.

Claim 9, the sole independent claim on appeal, is reproduced below:

> A method for producing a foam body part having at least one adhesive closing part with adhering elements, comprising the steps of:
>
> arranging an adhesive closing part in a foaming mold for forming a foamed body part, the adhesive closing part having first and second opposite surfaces and having adhering elements extending from said first surface;
>
> protecting the adhering elements on the adhesive closing part against penetration of foam by arranging a foam-inhibiting covering on said second surface of the adhesive closing part to

[2] Claim 19 is also pending in the Application and was rejected under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 103(a). However, both of these rejections were withdrawn by the Examiner in the Examiner's Answer dated November 20, 2008 ("Ans."), at 3.

[3] REMAND TO THE EXAMINER dated September 30, 2005 ("Remand"), and ORDER REMANDING TO THE EXAMINER dated September 28, 2006.

be remote from the adhering elements, the foam-inhibiting covering having a predetermined peripheral border width overlapping and extending beyond a surface area of the adhering elements; and

bringing the foam-inhibiting covering into detachable contact with parts of the foaming mold by permanent magnets in parts of the foaming mold attracting a ferromagnetic coating extending throughout the entire length and width of the foam-inhibiting covering, the permanent magnets being placed laterally about a periphery of a portion of the foaming mold receiving the adhering elements of the adhesive closing part to cooperate with the peripheral border of the covering overlapping the surface area of the adhering elements.

App. Br., Claims Appendix.[4]

The following Examiner's rejections and objections are before us on appeal:

(1) Claims 9-18 are rejected under 35 U.S.C. § 112, first paragraph, based on the written description requirement.

(2) The Amendment dated January 15, 2003, is objected to under 35 U.S.C. § 132 as introducing new matter into the disclosure of the invention.[5]

(3) Claims 9-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Billarant[6] and Provost.[7]

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[4] Appeal Brief dated April 19, 2004.
[5] As explained in the Remand, the Amendment affects the claims. Therefore, the objection is properly before the Board. Remand 2, n.2.
[6] US 5,422,156 issued to Billarant on June 6, 1995.
[7] WO 86/03164 published June 5, 1986.

ISSUES

(1) Have the Appellants identified reversible error in the Examiner's finding that the original disclosure does not provide written description support for "a ferromagnetic coating extending throughout the entire length and width of the foam-inhibiting covering" as recited in claim 9?

(2) Have the Appellants shown that the Examiner erroneously objected to the Amendment dated January 15, 2003, under 35 U.S.C. § 132 as introducing new matter into the disclosure of the invention?

(3) Have the Appellants identified reversible error in the Examiner's finding that Billarant discloses an adhering element protected against penetration of foam by a foam-inhibiting covering arranged on the second surface of the adhesive closing part as recited in claim 9?

PRINCIPLES OF LAW

The test for determining compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, is whether the disclosure of an application, as originally filed, reasonably conveys to one of ordinary skill in the art that the inventor had possession at that time of the later claimed subject matter. *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983).

"[T]he invention claimed does not have to be described in ipsis verbis in order to satisfy the description requirement of § 112." *In re Lukach*, 442 F.2d 967, 969 (CCPA 1971). However, the description must be sufficiently clear that one of ordinary skill in the art would have recognized from the disclosure that the applicant invented the later claimed subject matter. *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976).

The test for determining compliance with the written description requirement "is not whether a claimed invention is an obvious variant of that which is disclosed in the specification." *Lockwood v. American Airlines*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

ISSUES (1) and (2)

In the Amendment dated January 15, 2003, the Appellants added the phrase "the subject matter of which is hereby incorporated by reference" to paragraph [0017] of the substitute Specification. The Amendment also added the phrase "length and width of the" to the following phrase in claim 9: "a ferromagnetic coating extending throughout the entire foam-inhibiting covering."[8] The Examiner found that the amendments to the Specification and claim 9 introduce new matter into the disclosure of the invention. Ans. 4.

A. FINDINGS OF FACT

The original disclosure of the instant Application states, in relevant part:

> For this purpose it is possible to proceed so that the covering element is provided with a ferromagnetic coating, for example with a coating of polyurethane, as is commercially available under the name SU-9182 by Firma Stahl, which contains admixed Fe particles of granular size <10µ as ferromagnetic material.

Original sheets, 3:12-15.

> The tight connection of adhering elements 5 with covering element 15 . . . can also occur directly through a polyurethane

[8] In a previous Office Action, the Examiner found that the phrase "a ferromagnetic coating extending throughout the entire foam-inhibiting covering" also lacks written description support. *See* Office Action dated August 1, 2002, at 2.

> coating containing ferromagnetic substances, which can be for example the polyurethane SU-9182 of Firma Stahl.

Original sheets, 5:21-24.

Amended paragraph [0017] of the substitute Specification reads, in relevant part, as follows:

> The tight connection of adhering elements 5 with covering element 15 . . . can also occur directly through a polyurethane coating containing ferromagnetic substances. Such coating can be for example the polyurethane SU-9182 of Stahl Holland B.V. of Waalwijk Holland, *the subject matter of which is hereby incorporated by reference*.

Amendment dated January 15, 2003, at 1-2 (emphasis added).

We find that "SU-9182 of Firma Stahl" and "SU-9182 of Stahl Holland B.V. of Waalwijk Holland" refer to the same polyurethane product. *See* Declaration of Konstantinos Poulakis dated November 10, 2006, paras. 3, 4. We refer to that product as the "Stahl SU-9182 product."

B. ANALYSIS

1. Amendment to the Specification

The Examiner appears to be of the opinion that the reference to "polyurethane SU-9182 of Stahl Holland B.V. of Waalwijk Holland" in amended paragraph [0017] of the Specification refers to a publication. Thus, relying on MPEP § 608.01(p), the Examiner contends that the phrase "the subject matter of which is hereby incorporated by reference" introduces new matter. Ans. 8.

The Appellants contend that the phrase "the subject matter of which is hereby incorporated by reference" merely states what is implicit in the original disclosure, i.e., that the Stahl SU-9182 product is used in connection with the covering element. The Appellants direct our attention to several

portions of the original disclosure for support (i.e., p. 3, ll. 12-15; p. 5, ll. 21-24, claim 6). App. Br. 6-7.

Based on the record before us, we find that "polyurethane SU-9182 of Stahl Holland B.V. of Waalwijk Holland" refers to a polyurethane product not a publication. *See* English Translation of the "Material Safety Data Sheet" for SU-9182 filed November 20, 2006. Thus, the considerations discussed in MPEP § 608.01(p) are not applicable to the facts in this case.

Since the phrase "the subject matter of which is hereby incorporated by reference" does not refer to a publication, it fails to incorporate anything by reference into the disclosure, and thus, does not introduce new matter. That being said, we find that the portions of the original disclosure relied on by the Appellants make it clear that, at the time the instant application was filed, the Appellants had possession of a covering element provided with a coating of the Stahl SU-9182 product. *See, e.g.,* p. 3, ll. 12-15 of the original sheets.

2. Amendment to claim 9

The Appellants argue that reference to the Stahl SU-9182 product provides written description support for a ferromagnetic coating extending throughout the entire foam-inhibiting covering. The Appellants also argue that portions of the original disclosure, reproduced above, "would convey to those skilled in the art that the ferromagnetic particles extend throughout the coating for the covering element 15." App. Br. 7-8.

The issue before us is not whether the original disclosure describes ferromagnetic particles extending throughout the entire coating. Rather, the issue is whether the original disclosure describes that the coating (which

contains ferromagnetic particles) extends throughout the entire length and width of the covering element 15.

The portions of the original disclosure relied on by the Appellants establish that the covering element is provided with a coating, but they do not discuss the extent of the coating, i.e., that it extends throughout the *entire length and width* of the covering element. As for the reference to the Stahl SU-9182 product, the evidence of record merely establishes that the product is a "solvent-containing polyurethane." *See* English Translation of the "Material Safety Data Sheet" for SU-9182 filed November 20, 2006.

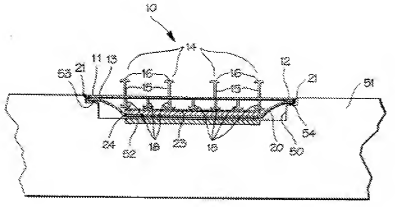
For the reasons set forth above, the Appellants have failed to establish that the original disclosure provides written description support for amended claim 9.

ISSUE (3)

A. FINDINGS OF FACT

Billarant discloses a fastening member of the type which is molded into molded foam cushions, such as seat cushions used in automobiles and other vehicles. Billarant 1:7-9.

Billarant Figure 6 illustrates the use of the fastening member in a foam molding operation. Billarant 4:7-8. Figure 6 is reproduced below:



Billarant Figure 6 depicts a fastening member.

Fastening member 10 includes a base 11. Billarant 4:47-48.

Several rows of anchoring elements 14 are molded into one side of the base 11. Billarant 4:51-53.

The anchoring elements 14 project outwardly away from the mold 51 and are intended to be immersed in the molding liquid when the molding process begins. Billarant 4:60-63.

The other side of the base 11 carries hook-like projections 18. These projections are intended to mate with material attached to a seat cushion. Billarant 4:64-5:3.

The projections 18 are covered and enclosed by a temporary protective film 20. Billarant 5:7-10.

The protective film 20 protects the projections 18 from contamination by molding liquid during the molding process. Billarant 5:16-18.

B. ANALYSIS

The Examiner found that the adhesive closing part of Billarant comprises first (15) and second (18) opposite surfaces and adhering elements extending from the first surface (15). The Examiner found that

Billarant discloses that the adhering elements on the adhesive closing part are protected against penetration of foam by arranging a foam-inhibiting covering 20 on the second surface (18) of the adhesive closing part remote from the adhering elements. Ans. 5.

The Appellants contend that interpreting the covering 20 as being remote from adhering elements 15 and protecting adhering elements 18 does not satisfy the language of claim 9. The Appellants argue that the claim clearly requires the covering to be "remote from and protect the same adhering elements, not different adhering elements" as alleged by the Examiner. Reply Br. 4.[9]

The Appellants' position is well supported by the record. Claim 9 recites that the adhesive closing part has "first and second opposite surfaces" and "adhering elements extending from said first surface." The adhering elements that extend from the *first* surface are protected against penetration of foam by "arranging a foam-inhibiting covering on said second surface of the adhesive closing part to be remote from the adhering elements."

According to the Examiner's findings, covering element 20 protects the adhering elements extending from the *second* surface (i.e., adhering elements 18) rather than the adhering elements extending from the *first* surface (i.e., adhering elements 15) as required by claim 9. The Examiner has failed to offer any reason why Billarant, either alone or in combination with Provost, would have suggested using covering element 20 to protect adhering elements 15. Thus, we are constrained to reverse the rejection under §103(a).

[9] Reply Brief dated October 25, 2004.

DECISION

The January 15, 2003 Amendment to the Specification was improperly objected to under 35 U.S.C. § 132 as introducing new matter into the disclosure of the invention.

The January 15, 2003 Amendment to claim 9 was properly objected to under 35 U.S.C. § 132 as introducing new matter into the disclosure of the invention.

The rejection of claims 9-18 under 35 U.S.C. § 112, first paragraph, based on the written description requirement is affirmed.

The rejection of claims 9-18 under 35 U.S.C. § 103(a) as unpatentable over the combination of Billarant and Provost is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

psb

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